

**REMARKS**

Claims 1 and 32–47 are pending in the present application. Claims 46–47 have been withdrawn from consideration, but not canceled.

Reconsideration of the claims is respectfully requested.

**35 U.S.C. § 112, First Paragraph (Written Description)**

Claims 1 and 32–45 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This rejection is respectfully traversed.

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. MPEP § 2163; *In re Kaslow*, 707 F.2d 1366, 1375, 217 U.S.P.Q. 1089, 1096 (Fed. Cir. 1983); *In re Edwards*, 558 F.2d 1349, 1351, 196 U.S.P.Q. 465, 467 (CCPA 1978); *In re Herschler*, 591 F.2d 693, 701, 200 U.S.P.Q. 711, 717 (CCPA 1979). To satisfy the written description requirement, the claimed invention need not be expressed *ipsis verbis* in the original specification. MPEP § 2163; *In re Wertheim*, 541 F.2d 257, 262, 190 U.S.P.Q. 90, 96 (C.C.P.A. 1976) ("It is not necessary that the application describe the claim limitations exactly, . . . but only so clearly that persons of ordinary skill in the art will recognize from

the disclosure that appellants invented processes including those limitations."); *In re Wright*, 866 F.2d 422, 425, 9 U.S.P.Q.2d 1649, 1651 (Fed. Cir. 1989) ("[T]he claimed subject matter need not be expressed *in haec verba* in the specification in order for that specification to satisfy the written description requirement.").

The Office Action states:

Newly presented claims 1 and 38 both recite a step of growing a field oxide on the first and second isolation areas in a single isolation oxidation step. Such limitation has never been disclosed in the specification as originally filed. This is a new matter rejection.

Paper No. 9, page 3. However, the specification as filed teaches: patterning a resist 120A to etch openings over isolation areas 130A "to expose silicon in the isolation areas in the n-type region (steps 2 and 3 on page 7); remove photoresist 120A (step 6 on page 8); pattern a resist 120B to etch opening over isolation areas 130B "to expose silicon 104 in the isolation areas 103B[ in t]he p-type region" (step 8 and 9 on page 8); remove all resist (step 11 on page 8); and then growing field oxide (step 13 on page 8). Because all resist is removed, a single thermal oxidation step will grow oxide on all areas left exposed by the oxidation barrier. Thus, although the application does not expressly state that field oxide is grown on both the first and second isolation areas where exposed by the oxidation barrier in a single oxidation step, those skilled in the art will readily recognize that this result will inherently occur during thermal oxidation after patterning the oxidation barrier to expose both the first and second isolation areas and removing all resist, leaving both the first and second isolation areas exposed during oxidation.

In addition, independent claims 1, 11 and 21 as originally filed in the application each recite steps for patterning the oxidation barrier to expose isolation areas in both the p-type and n-type regions, then “growing a field oxide on said body where exposed by said oxidation barrier layer.” Those skilled in the art will readily recognize that, having patterned the oxidation barrier to expose isolation areas in both the p-type and n-type regions, the step of growing a field oxide on all exposed areas will necessarily and inherently produce oxide on both p-type and n-type isolation regions by a single oxidation step.

Therefore, the rejection of claims 1 and 32–45 under 35 U.S.C. § 112, first paragraph has been overcome.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this

Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *dvenglarik@davismunck.com*.

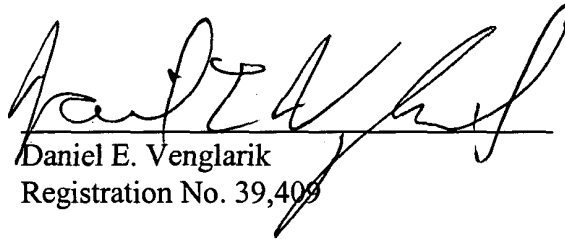
The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date:

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